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# TRANSMITTAL LETTER AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313



RE: Attorney Docket No.: OSEM-DB3
Application No.: 09/636,484
Filed: 08/10/00
Title: INTEGRATED TRANSISTOR DEVICES
Inventor: Braddock, David

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.181 PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT (6 PAGES)

Our check in the amount of $130.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

31518
PATENT TRADEMARK OFFICE

6/14/04
Date

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: June 14, 2004 (12:05pm)
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OLD DOCKET NO: DB3 - NEW DOCKET NO: OSEM-DB3

IN RE APPLICATION OF: Braddock Examiner: KANG

SERIAL NO: 09/636,484 GROUP ART UNIT: 2811

FILED: 08/10/00

TITLE: INTEGRATED TRANSISTOR DEVICES



TO: ASSISTANT COMMISSIONER OF PATENTS

37 CFR 1.181 PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT



Sir:

The applicant petitions for correction of various procedural irregularities.



06/15/2004 CCHAU1 00000187 09636484

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## I. Statement of Relief Requested

The applicant petitions:

(A) to have the petition file 1/6/2004 and re-filed 4/23/2004 timely decided (which petition requests (1) that the "Notification of Non-Compliance With 37 CFR 1.192(c)" mailed 10/21/2003 be VACATED and (2) that the appeal brief originally filed April 29, 2003 and re-filed September 25, 2003 be considered on appeal);

(B) the information disclosure statements filed 2/27/2004 and 4/14/2004 entered and considered by the examiner, that

(C) the amendment filed 4/29/2003 be entered

(d) the examiner's answer mailed 5/28/2004 be withdrawn.

## II. Material Facts

A check for the petition fee is enclosed herewith.

On 7/15/2002, the PTO mailed an office action in which the examiner withdrew claims 53-55.

On November 14, 2002, the applicant filed a combined appeal brief and request to have claims 53-55 reinstated.

On 1/30/2003, the PTO mailed an office action reopening prosecution and making the withdrawal of claims 53-55 final. Upon mailing of this office action prosecution was open and not final.

On 3/3/2003, the applicant filed a petition for withdrawal of the restriction requirement.

On 3/26/2004 the USPTO mailed a decision granting the petition to have the restriction requirement withdrawn.

On 4/29/2003, the applicant filed an appeal brief, and an amendment and associated evidence.

On 9/25/2003, the applicant re-filed the papers apparently lost by the USPTO, including the appeal brief, and an amendment and associated evidence originally filed 4/29/2003.

On 11/21/2003, the USPTO mailed a notification of non-compliance of the appeal brief filed 4/29/2003 for a reason that "claim 36 has been amended and there has been no second rejection of claim 36 in this patent application." The notification apparently indicated that the amendment, evidence, and appeal brief originally filed 4/29/2003 and refiled 9/25/2003 were not being entered or considered.

On 10/28/2003, the applicant filed (1) a response to the notification of non-compliance of the appeal brief requesting reconsideration of the notice and its requirement and (2) a 37 CFR 1.193(b)(2)(ii) request to reinstate the appeal and supplemental appeal brief complying with the requirement.

On 11/6/2003, the applicant filed a request to record an assignment of this application.

On 1/6/2004, the applicant filed a petition in response to the notification of non-compliance mailed 11/21/2003.

On 2/27/2004, the applicant filed an IDS citing USP patents identified as U-1 to U-57, non-patent literature L-1 and L-9, and certain related applications.

On 4/14/2004, the applicant filed an IDS citing reference L-10.

On 4/23/2004, the applicant re-filed the apparently lost earlier filing on 1/6/2004 of the petition in response to the notification of non-compliance mailed 11/21/2003..

On 5/28/2004, the USPTO mailed an examiner's answer which states on its cover that it is responsive to the appeal brief filed October 28, 2003.

No paper mailed by the USPTO acknowledges the IDSs filed 2/27/2004 and 4/14/2004.

No paper mailed by the USPTO responds to the petition file 1/6/2004 and refiled 4/23/2004.

No paper mailed by the USPTO enters the amendment originally filed 4/29/2003 and re-filed 9/25/2003.

## III. Reasons Why The Petition Should be Granted

The examiner withdraw the finality by re-opening prosecution with the non-final office action mailed 1/30/2003. Amendments filed after that date and IDSs filed after that date should

have been entered. The amendment filed 4/29/2003 (and associated evidence filed with it) should therefore have been entered. The two IDSs filed 2/27/2004 and 4/14/2004 should therefore have been considered. The appeal brief filed 4/29/2003 should have been entered.

The notification required an appeal brief filed that did not refer to claims as they would be amended if the amendment originally filed 4/29/2003 were entered. The stated reasons ("claim 36 has been amended and there has been no second rejection of claim 36 in this patent application.") for the examiner to consider the appeal brief filed 4/29/2003 non-compliant is a non-sequitur. In fact, neither amendment nor second rejection of a claim is required prior to an appeal. All that is required under ***binding precedent*** is that a claim ***for a patent*** (as opposed to a claim in a patent application) has been twice or more rejected. [Ex parte Lemoine, 46 USPQ2d 1420, ___ (PTOBPAI 1994)(precedential decision of an expanded panel including APJ Schafer, APJ Meister, SAPJ McKelvey, and CAPJ Stoner), stating that:

> Considering these sections together, we conclude that "claims" as used in §134 is a reference to the repeated "claim for a patent" as used in §132 rather than a reference to a particular claim "of an application." Under our interpretation, ***so long as the applicant has twice been denied a patent, an appeal may be filed.*** So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction. [Bold and italics added for emphasis.]

Accordingly, the notification of non-compliance and corresponding requirement that forced the applicant to file the 10/28/2003 version of the appeal brief were clearly procedurally improper as not in accordance with controlling law. Therefore, the notification should have been vacated or withdrawn, as I previously requested. Moreover, the amendment, evidence, and appeal brief filed 4/29/2003 should likewise have been entered and acted on by the examiner, instead of the subsequent brief filed to in response to the notification in order to avoid the abandonment threatened in the notification.

Please note that the notification violates the Administrative Procedures act. See 5 USC 706. 5 USC 706 is entitled "Scope of review," and it states that:

> To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall--
>
> **(1) compel agency action unlawfully withheld or unreasonably delayed; and**
>
> **(2) hold unlawful and set aside agency action, findings, and conclusions found to be--**
>
> **(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; ....**

Accordingly, since the notification was based upon an improper legal conclusion that an appeal was improper after "***the applicant has twice been denied a patent,***" i.e., a conclusion completely inconsistent with binding precedent, the notification and its requirement were "unlawful" and therefore "**an abuse of discretion, or otherwise not in accordance with law.**" Moreover, actions that are contrary to binding precedent are clearly "**arbitrary, capricious, an abuse of discretion..**" Accordingly, the USPTO does not have discretion in deciding ***whether*** to reverse the notification since, if it does not reverse the notification, it will be in violation of the APA. In that case, I will ask the reviewing court to reverse the notification, and it will do so.

The examiner's answer mailed 5/28/2004 addresses versions of claims that will no longer be pending once the relief mentioned above is granted. Accordingly, the USPTO should **promptly** officially withdraw that answer to avoid yet further waste of the applicant's time and resources in responding thereto.

Thus, the USPTO should grant this and the formerly filed and undecided petition by granting the relief requested in full.

Respectfully Submitted,

6/11/04

Date

31518

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